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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,424	03/07/2002	Evan R. Kirshenbaum	10015991-1	8876

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HEWLETT-PACKARD COMPANY  
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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/091,424	Applicant(s) KIRSHENBAUM ET AL.	
	Examiner Charlie C. Agwumezie	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Status of claims*

1. Claims 35 and 36 are newly added independent claims. Claims 1-36 are pending in this application per the response to office action filed by Applicant on May 17, 2005.

### Request to Reopen Prosecution

2. A request to reopen prosecution in this application following a Pre-Appeal Brief For Review filed October 27, 2005 is granted.

### *Response to Arguments*

3. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claim 1-2, 4-7, 9, 13, 15-28, and 30-34,** are rejected under 35 U.S.C. 102(e) as being anticipated by Chasko U.S. Patent No. 6,901,373.

5. As per **claim 1, 21, 32 and 33**, Chasko discloses a system for customer-side market segmentation while preventing disclosure of sensitive customer information, comprising:

a non-merchant-controlled device having a means for generating a category code based on a business-specific decision procedure and stored customer information, wherein the customer information is kept private from merchants based on specified criteria (see fig. 3; col. 2, lines 9-17, 35-37, 42-67; col. 3, lines 10-30; col. 5, lines 8-50);

a first merchant-controlled means for providing the business-specific decision procedure to the non-merchant-controlled device (see fig. 3; col. 5, lines 50 – col. 6, lines 38); and

a second merchant-controlled means for receiving a category code from the non-merchant-controlled device (see fig. 3, col. 7, lines 1-35).

6. As per **claim 2**, Chasko et al further discloses the system, further comprising customer-controlled means for specifying the criteria used to keep information private (col. 2, lines 9-17, 35-37).

7. As per **claim 4**, Chasko further discloses the system, wherein the first and second merchant-controlled means are integrated as one physical unit as a promotional device (see fig. 1; col. 3, lines 17-30; col. 4, lines 9-20).

Art Unit: 3621

8. As per **claim 5 and 29**, Chasko further discloses the system, wherein the non-merchant-controlled device is a customer-controlled device (col. 4, lines 10-19, 27-39).
9. As per **claim 6**, Chasko further discloses the system, wherein the non-merchant-controlled device is a third-party-controlled device (col. 2, lines 41-55).
10. As per **claim 7**, Chasko further discloses the system, wherein customer identification is masked to prevent identification of the customer by a merchant (col. 1; lines 20-40; col. 2, lines 35-37).
11. As per **claim 9**, Chasko further discloses the system, wherein the first merchant-controlled means device provides identification information to the non-merchant-controlled device, and wherein the non-merchant-controlled device utilizes configurable safeguards combined with the provided identification to prevent undesirable release of customer information (Col. 5, lines 50- col. 6, lines 10; col. 8, lines 25-54).
12. As per **claim 13**, Chasko further discloses the system, wherein the non-merchant-controlled device queries the customer for additional information responsive to receipt of the business-specific decision procedure (col. 8, lines 39-67).
13. As per **claim 15**, Chasko further discloses the system, wherein the non-

Art Unit: 3621

merchant-controlled device further comprises means for performing sensitivity analysis on the business-specific decision procedure, thereby determining whether sensitive information is to be revealed to a merchant based on the categorization (col. 2, lines 9-17).

14. As per **claim 16**, Chasko further discloses the system wherein the business-specific decision procedure masks rules and resulting categories to prevent reverse-engineering of the decision procedure (col. 6, lines 39-67)

15. As per **claim 17**, Chasko further discloses the system, further comprising means for providing promotional material to a customer (col. 6, lines 66 – col. 7, lines 25).

16. As per **claim 18**, Chasko further discloses the system, wherein the means for providing promotional material comprises a printing device (col. 3, line 50 – col. 4, line 9)

17. As per **claim 19**, Chasko further discloses the system wherein the non-merchant controlled device is a customer-controlled personal digital assistant (PDA) (col. 1, lines 5-20)

18. As per **claim 20**, Chasko further discloses the system wherein the non-merchant-controlled device queries the customer for additional information responsive to receipt of

Art Unit: 3621

a business-specific decision procedure, and wherein the PDA provides means for entering additional information requested by the query (col. 8, lines 39-67).

19. As per **claim 22**, Chasko further discloses the method, further comprising: providing promotional material to the customer by a business, wherein the business provides the business-specific decision procedure received by the non-merchant-controlled device, and wherein the promotional material is customized based on the identified customer category (see fig. 1; col. 2, lines 42- 67).

20. As per **claim 23**, Chasko further discloses the method, wherein the promotional material is selected from a group consisting of discount coupons, advertisements, product information, business information; competitor comparisons, product comparisons, special offers and feedback requests (col. 6, line 66 –col. 7, line 25).

21. As per **claim 24**, Chasko further discloses the method, wherein promotional information is printed at a business location and provided to a customer shopping at the business location (col. 3, lines 50-67).

22. As per **claim 25**, Chasko further discloses the method, wherein the non-merchant-controlled device is a customer-controlled device (col. 1, lines 5-20).

23. As per **claim 26**, Chasko further discloses the method, wherein promotional

information is displayed on the customer-controlled device (col. 1, lines 5-20).

24. As per **claim 27**, Chasko further discloses the method, further comprising steps of: querying the customer for additional information by the non-merchant-controlled device, responsive to receiving a business-specific decision procedure; and inputting additional information by the customer, wherein the additional information is added to the stored customer-specific information for use by the categorizer (col. 2, lines 42- 67).

25. As per **claim 28**, Chasko further discloses the method, further comprising steps of: capturing additional information related to the customer, wherein the additional information comprises at least one item selected from the group consisting of customer behavior, outside factors, and customer mode; and expanding the stored customer-specific information with the additional information, wherein the additional information is used by the categorizer to provide an updated customer category (see fig. 3; col. 2, lines 42- 67).

26. As per **claim 30**, Chasko further discloses the method, further comprising: providing promotional material to the customer by a business, wherein the business provides the business-specific decision procedure received by the third-party-controlled device, and wherein the promotional material is customized based on the identified customer category (see fig. 1; col. 2, lines 42- 67).



27. As per **claim 31**, Chasko further discloses the method, further comprising steps of: performing sensitivity analysis on the decision procedure to safeguard sensitive information, by the customer (col. 2, lines 9-17).

28. As per **claim 34**, Chasko further discloses the computer readable medium, further comprising a fourth code section for determining a preferred action based on the customer category received (col. 2, lines 42-67).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. **Claim 3, 35 and 36**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko U.S. Patent 6,901,373 in view of McCollom et al U.S. Patent No. 6,343,274.

30. As per **claim 3**, Chasko failed to explicitly disclose the system, wherein the business-specific decision procedure is provided to the non-merchant-controlled device

Art Unit: 3621

over a public, global communication network and the category code is also sent over the public, global communication network from the non-merchant-controlled device.

McCollom et al discloses the system, wherein the business-specific decision procedure is provided to the non-merchant-controlled device over a public, global communication network and the category code is also sent over the public, global communication network from the non-merchant-controlled device (fig. 1).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Chasko and provide a system wherein the business-specific decision procedure is provided to the non-merchant-controlled device over a public, global communication network and the category code is also sent over the public, global communication network from the non-merchant-controlled device in view of the teachings of McCollom et al in order to ensure adequate means of communication.

31. As per **claim 35 and 36**, Chasko discloses a computer readable medium storing computer executable process steps for providing the customer related information, said process steps comprising:

obtaining and storing customer information (fig. 3; col. 1, lines 5-20)

receiving business-specific decision procedure from different business (fig. 3);

Upon receiving a particular business-specific decision procedure from a requesting business, processing the customer information based on said particular business-specific decision procedure, subject to specified customer privacy criteria, in

Art Unit: 3621

order to obtain processed customer information (see fig. 3; col. 2, lines 9-17, 35-37, 42-67; col. 3, lines 10-30; col. 5, lines 8-50); and

Sending the processed customer information to the requesting business (col. 3, lines 1-30; col. 8, lines 39-67).

What Chasko does not explicitly teach is receiving business-specific decision procedure from different business.

McCollom et al discloses receiving business-specific decision procedure from different business (col. 2, lines 30-44; col. 12, lines 60-67)

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Chasko and provide a system wherein the business-specific decision procedure is received from different business in view of the teachings of McCollom et al in order to show that the system does serve plurality of merchants.

32. **Claim 8, 12, and 14**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko U.S. Patent 6,901,373 in view of Vanska et al, U.S. Patent Application Publication 2002/0147766.

33. As per **claim 8**, Chasko failed to explicitly disclose the system, wherein the first merchant-controlled means selects the third-party-controlled device from a plurality of third-party devices based on customer preferences.

Vanska et al, discloses the system, wherein the first merchant-controlled means selects the third-party-controlled device from a plurality of third-party devices based on customer preferences (see fig. 6A and B, 0054).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Chasko and provide a system wherein the first merchant-controlled means selects the third-party-controlled device from a plurality of third-party devices based on customer preferences in view of the teachings of Vanska et al in order to show alternative method of implementation.

34. As per claim 12, Chasko failed to explicitly disclose the system, wherein the first merchant-controlled means device further comprises a proximity detector for detecting the presence of a non-merchant-controlled device.

Vanska et al, discloses the system, wherein the first merchant-controlled means device further comprises a proximity detector for detecting the presence of a non-merchant-controlled device (fig. 8A; 0061, 0075, 0077, 0079, 0147).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Chasko and provide a system wherein the first merchant-controlled means device further comprises a proximity detector for detecting the presence of a non-merchant-controlled device in view of the teachings of Vanska et al in order to indicate the presence of customer.

Art Unit: 3621

35. As per claim 14, Chasko further discloses the system, wherein the non-merchant-controlled device comprises a portable device and a personal computer (PC), the PC providing means for entering additional information requested by the query, wherein the additional information entered into the PC is transferred to the portable device at the request of the customer, and wherein the portable device is used for interaction with the promotional device (see fig. 3; col. 1; lines 5-20; col. 2, lines 42-67).

36. Claims 10 and 11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chasko U.S. Patent 6,901,373 in view of Ginter et al U.S. Patent 6,185,683.

37. As per claim 10, Chasko failed to explicitly disclose the system, wherein the identification information uses an identity token.

Ginter et al discloses the system, wherein the identification information uses an identity token (col. 8, lines 15-22).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Chasko and provide a system wherein the identification information uses an identity token in view of the teachings of Ginter et al in order to ensure adequate security.

38. As per claim 11, Chasko failed to explicitly disclose the system, wherein the identification information uses a digital certificate.

Art Unit: 3621

Ginter et al discloses the system, wherein the identification information uses a digital certificate (col. 80, lines 10-19).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Chasko and provide a system wherein the identification information uses a digital certificate in view of the teachings of Ginter et al in order to ensure adequate security.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on **(571) 272 – 6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

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Art Unit: 3621

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**Charlie Lion Agwumezie  
Patent Examiner  
Art Unit 3621  
December 19, 2005**

*Stella June A.*  
**PRIMARY EXAMINER**